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09/820,760	03/30/2001	Yasuhisa Fujiwara	108207	3858
25944	7590	10/29/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/820,760

Applicant(s)

FUJIWARA, YASUHISA

Examiner

Robert M. Pond

Art Unit

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **SUPPLEMENTAL OFFICE ACTION**

Finality of the previous Office Action mailed on 25 August 2004 is voluntarily withdrawn. The Examiner issued new grounds of rejection under 35 USC 101 and 35 USC 112 necessitating a non-final action. This Supplemental Office Action replaces the Detailed Action submitted in the previous Office Action. The Examiner regrets any inconvenience to the Applicant.

A shortened statutory period for reply to this the previously filed final Office Action and this Supplemental Response is set to expire THREE MONTHS from the mailing date of this action.

#### ***Response to Amendment***

The Applicant amended Claims 1, 2, 5, 7-13, and 15 and based arguments on the amended claims. All pending claims (1-16) were examined in this non-final Office Action necessitated by new grounds of rejection under 35 USC 101 and 35 USC 112.

#### ***Response to Arguments***

##### **Rejection under 35 USC 102(e)**

Applicant's arguments filed 14 June 2004 have been fully considered but they are not persuasive.

The Applicant amended Claims 1, 2, 5, 7-13, and 15 and based arguments on the amended claims. The Applicant respectfully argued in multiple instances the prior art offers no provision for a user to schedule parts installation by a repair shop on a user-specified repair date.

Rejection under 35 102(e) was withdrawn as necessitated by amendment resulting in rejection under 35 USC 103(a) based on previously cited art. The Examiner respectfully requests the Applicant to consider the following:

- Hyundai teaches: an automotive web site allowing users to order parts online; specifically cites parts for installation; users searching a dealership for parts destination; and dealerships providing automotive service.
- BW teaches: an automotive web site allowing users to order parts online; scheduling automotive service appointments online; and the online web site providing convenience and efficiency for the user and service provider.

In combination with Hyundai, Hyundai and BW teach parts ordering for installation and scheduling automotive service appointments online as being convenient and efficient for the user and service provider. Regarding a user-specified installation date, it is this Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling a service appointment pertains to at least scheduling a date for the service. Furthermore, a) scheduling a date for service is neither

convenient nor efficient for the user without at least ascertaining when the user can make the vehicle available for service, and b) scheduling a date for service is neither convenient nor efficient for the user and service provider without at least making the user aware of what dates are available for service.

*Official Notice (Paper #5, regarding service appointment information)*

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Please see line 20: "providing the at least one candidate facility..."

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

**2. Claim 9 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over Hyundai (a collection of prior art regarding Hyundai's Parts Online extranet, Paper #5, PTO-892, Items: U-W), in view of BW (Paper #5, PTO-892, Item: UU),**

Hyundai teaches an electronic commerce method that allows users to order automotive parts online by accessing a web site. Hyundai teaches the web site being implemented with Windows NT servers and extranet technology. Hyundai further teaches:

- Image data; transmitting image data: online user receives repair information, data, and diagrams to ensure proper installation of parts (U: see at least page 2).
- Matching parts: VIN ensures precise parts matching (U: see at least page 2).
- Users ordering parts: part ordering is easily accomplished with a few mouse clicks; access "order parts and accessories;" receiving matching parts, and pick up order of selected part(s) (U: see at least page 2).

- A server computer connected to a communications network: Users access the Parts Online web site via a communications network (e.g. Internet); Windows NT servers manage the web site and serve as a front end to legacy systems and databases (W: see at least page 2).
- Input means to database: user's enter information using web interface; query Hyundai's database (W: see at least page 2); User is asked to type year, model, VIN number; VIN ensures precise parts matching during search (U: see at least pages 1-2) (please note disclosures pertaining to online parts catalog hosted by the catalog publisher (first database) and Hyundai's database (second database)).
- Means for searching for a facility; transmitting the obtained facility data to user terminal: for user selects the dealer at the Web site; dealers provide parts and service; 20% of users are interested in using the dealer for service (V: see at least page 2); user enters zip code to determine nearest dealership (please note examiner's interpretation: zip code location chosen by the user is a convenient location for the user); queries are executed by servers accessing Hyundai databases (W: see at least page 2).
- Output display means: Transmits parts information, data, and diagrams to user to ensure proper installation of parts (U: see at least page 2); NT servers present graphics (W: see at least page 2).



- Receiving item data and user identification at the server and a user-specified installation date; searching for a facility; transmitting the obtained facility data to user terminal; item can be installed on the user-specified installation date:

Online service scheduling

Hyundai teaches all the above as noted under the 103(a) rejection and teaches a) a user ordering parts for installation, and selecting one or more parts by typing year, model, and VIN number (U: see at least pages 1-2), b) at the Web site a user entering zip code to determine nearest dealership for the dealer and selecting dealer (W: see at least page 2), and c) the dealers providing parts and service, and users interested in using the dealer for service (V: see at least page 2), but does not disclose online service scheduling. BW teaches Autoweb.com launching the Autoweb.com Service Center that offers a) consumers in-depth repair information, b) striving to give the consumer and service partners the most convenient, efficient experience, and further teaches Automweb.com providing consumers the ability to schedule automotive service appointments online (UU: see at pages 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Hyundai to implement online service scheduling as taught by BW, in order to provide users with an online service appointment scheduling services with a dealer,

and thereby attract users who want convenient and efficient online experiences.

*User-specified installation date*

Hyundai and BW teach all the above as noted under the 103(a) rejection and teach parts ordering for installation and scheduling automotive service appointments online as being convenient and efficient for the user and service provider, but do not specifically disclose a user-specified installation date. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and that scheduling a date for installation service is neither convenient nor efficient for the user without at least ascertaining when the user can make the vehicle available for installation service. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and that requesting a user-specified date for installation service is neither convenient nor efficient for the user and service provider without at

least making the user aware of what dates are currently available for installation service.

Pertaining to system Claim 7

Rejection of Claim 7 is based on the same rationale as noted above.

Pertaining to apparatus Claim 8

Rejection of Claim 8 is based on the same rationale as noted above.

4. **Claims 9 and 10 are rejected under 35 USC 103(a) as being unpatentable over Hyundai (a collection of prior art regarding Hyundai's Parts Online extranet, Paper #5, PTO-892, Items: U-W), in view of BW (Paper #5, PTO-892, Item: UU), further in view of Official Notice (Paper #5, regarding service appointment information).**

Hyundai teaches an electronic commerce method that allows users to order automotive parts online by accessing a web site. Hyundai teaches the web site being implemented with Windows NT servers and extranet technology. Hyundai further teaches:

- Image data; transmitting image data: online user receives repair information, data, and diagrams to ensure proper installation of parts (U: see at least page 2).
- Matching parts: VIN ensures precise parts matching (U: see at least page 2).

- Users ordering parts: part ordering is easily accomplished with a few mouse clicks; access "order parts and accessories;" receiving matching parts, and pick up order of selected part(s) (U: see at least page 2).
- A server computer connected to a communications network: Users access the Parts Online web site via a communications network (e.g. Internet); Windows NT servers manage the web site and serve as a front end to legacy systems and databases (W: see at least page 2).
- Input means to database: user's enter information using web interface; query Hyundai's database (W: see at least page 2); User is asked to type year, model, VIN number; VIN ensures precise parts matching during search (U: see at least pages 1-2) (please note disclosures pertaining to online parts catalog hosted by the catalog publisher (first database) and Hyundai's database (second database)).
- Means for searching for a facility; transmitting the obtained facility data to user terminal: for user selects the dealer at the Web site; dealers provide parts and service; 20% of users are interested in using the dealer for service (V: see at least page 2); user enters zip code to determine nearest dealership (please note examiner's interpretation: zip code location chosen by the user is a convenient location for the user); queries are executed by servers accessing Hyundai databases (W: see at least page 2).

- Output display means: Transmits parts information, data, and diagrams to user to ensure proper installation of parts (U: see at least page 2); NT servers present graphics (W: see at least page 2).
- Receiving item data and user identification at the server and a user-specified installation date; searching for a facility; transmitting the obtained facility data to user terminal; item can be installed on the user-specified installation date:

Online service scheduling

Hyundai teaches all the above as noted under the 103(a) rejection and teaches a) a user ordering parts for installation, and selecting one or more parts by typing year, model, and VIN number (U: see at least pages 1-2), b) at the Web site a user entering zip code to determine nearest dealership for the dealer and selecting dealer (W: see at least page 2), and c) the dealers providing parts and service, and users interested in using the dealer for service (V: see at least page 2), but does not disclose online service scheduling. BW teaches Autoweb.com launching the Autoweb.com Service Center that offers a) consumers in-depth repair information, b) striving to give the consumer and service partners the most convenient, efficient experience, and further teaches Automweb.com providing consumers the ability to schedule automotive service appointments online (UU: see at pages 1-3). Therefore it would have been obvious to one of ordinary skill in the art

at time of the invention to modify the method of Hyundai to implement online service scheduling as taught by BW, in order to provide users with an online service appointment scheduling services with a dealer, and thereby attract users who want convenient and efficient online experiences.

*User-specified installation date*

Hyundai and BW teach all the above as noted under the 103(a) rejection and teach parts ordering for installation and scheduling automotive service appointments online as being convenient and efficient for the user and service provider, but do not specifically disclose a user-specified installation date. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and that scheduling a date for installation service is neither convenient nor efficient for the user without at least ascertaining when the user can make the vehicle available for installation service. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and

that requesting a user-specified date for installation service is neither convenient nor efficient for the user and service provider without at least making the user aware of what dates are currently available for installation service.

- *Creating job management information:*

Hyundai and BW teach all the above as noted under the 103(a) rejection and teach a) selecting and ordering one or more parts for installation, b) communicating with the selected dealership using email to confirm order status, and c) scheduling service online with a dealership providing service, but do not disclose a creating job management information. This examiner takes the position that it is old and well-known that automotive service centers at least request information pertaining to the type of automobile to be serviced (e.g. make, model, year) and user name. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Hyundai and BW to create job management information as taught by Official Notice, in order for service shops to effectively service the online user, and thereby attract users to the online service.

*Pertaining to system Claim 10*

Rejection of Claim 10 is based on the same rationale as noted above.

5. **Claims 11-16 are rejected under 35 USC 103(a) as being unpatentable over Hyundai (a collection of prior art regarding Hyundai's Parts Online extranet, Paper #5, PTO-892, Items: U-W), in view of BW (Paper #5, PTO-892, Item: UU), further in view of PR Newswire (Paper #5, PTO-892, Item: X, hereinafter referred to as "PRN").**

Hyundai teaches an electronic commerce method that allows users to order automotive parts online by accessing a web site. Hyundai teaches the web site being implemented with Windows NT servers and extranet technology. Hyundai further teaches:

- Image data; transmitting image data: online user receives repair information, data, and diagrams to ensure proper installation of parts (U: see at least page 2).
- Matching parts: VIN ensures precise parts matching (U: see at least page 2).
- Users ordering parts: part ordering is easily accomplished with a few mouse clicks; access "order parts and accessories;" receiving matching parts, and pick up order of selected part(s) (U: see at least page 2).
- A server computer connected to a communications network: Users access the Parts Online web site via a communications network (e.g. Internet); Windows NT servers manage the web site and serve as a front end to legacy systems and databases (W: see at least page 2).



- Input means to database: user's enter information using web interface; query Hyundai's database (W: see at least page 2); User is asked to type year, model, VIN number; VIN ensures precise parts matching during search (U: see at least pages 1-2) (please note disclosures pertaining to online parts catalog hosted by the catalog publisher (first database) and Hyundai's database (second database).
- Means for searching for a facility; transmitting the obtained facility data to user terminal: for user selects the dealer at the Web site; dealers provide parts and service; 20% of users are interested in using the dealer for service (V: see at least page 2); user enters zip code to determine nearest dealership (please note examiner's interpretation: zip code location chosen by the user is a convenient location for the user); queries are executed by servers accessing Hyundai databases (W: see at least page 2).
- Output display means: Transmits parts information, data, and diagrams to user to ensure proper installation of parts (U: see at least page 2); NT servers present graphics (W: see at least page 2).
- Receiving item data and user identification at the server and a user-specified installation date; searching for a facility; transmitting the obtained facility data to user terminal; item can be installed on the user-specified installation date:

Online service scheduling

Hyundai teaches all the above as noted under the 103(a) rejection and teaches a) a user ordering parts for installation, and selecting one or more parts by typing year, model, and VIN number (U: see at least pages 1-2), b) at the Web site a user entering zip code to determine nearest dealership for the dealer and selecting dealer (W: see at least page 2), and c) the dealers providing parts and service, and users interested in using the dealer for service (V: see at least page 2), but does not disclose online service scheduling. BW teaches Autoweb.com launching the Autoweb.com Service Center that offers a) consumers in-depth repair information, b) striving to give the consumer and service partners the most convenient, efficient experience, and further teaches Automweb.com providing consumers the ability to schedule automotive service appointments online (UU: see at pages 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Hyundai to implement online service scheduling as taught by BW, in order to provide users with an online service appointment scheduling services with a dealer, and thereby attract users who want convenient and efficient online experiences.

*User-specified installation date*

Hyundai and BW teach all the above as noted under the 103(a) rejection and teach parts ordering for installation and scheduling

automotive service appointments online as being convenient and efficient for the user and service provider, but do not specifically disclose a user-specified installation date. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and that scheduling a date for installation service is neither convenient nor efficient for the user without at least ascertaining when the user can make the vehicle available for installation service. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a user-specified installation date, since one of ordinary skill in the art would ascertain scheduling an installation service appointment pertains to at least scheduling a date for the installation service, and that requesting a user-specified date for installation service is neither convenient nor efficient for the user and service provider without at least making the user aware of what dates are currently available for installation service.

- *Receiving a repair estimate:*

Hyundai and BW teach all the above as noted under the 103(a) rejection and teach a) online parts ordering for installation service, and b) scheduling installation service online, and c) automotive web sites

providing convenient and efficient online experiences for users, but do not disclose users receiving a repair estimate. PRN teaches users ordering parts online from a web site, and further teaches the user receiving repair cost estimates online (X: see pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Hyundai and BW to provide repair cost estimates as taught by PRN, in order for users to know how much the total cost of service is estimated to be, and thereby attract users to the online service by providing a service that is convenient and efficient.

*Pertaining to system Claims 12-14*

Rejection of Claims 12-14 is based on the same rationale as noted above.

*Pertaining to apparatus Claims 15-16*

Rejection of Claims 15-16 is based on the same rationale as noted above.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- JP-A-11-091516 (Michimoto) 06 April 1999; teaches reserving service at an automotive repair shop (cited in IDS submitted 19 April 2004).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

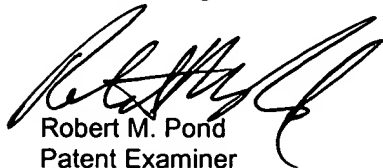
or faxed to:

**703-872-9306** (Official communications; including After Final communications labeled "Box AF")

Art Unit: 3625

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', is written over the printed name.

Robert M. Pond  
Patent Examiner  
October 26, 2004